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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,981

02/28/2005

Kyoko Ishimoto

2005-0264A

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11/14/2007

WENDEROTH, LIND & PONACK, L.L.P.

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SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

DEES, NIKKI H

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,981	Applicant(s) ISHIMOTO ET AL.	
	Examiner Nikki H. Dees	Art Unit 4174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>28 February 2005, May 15, 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Emoto (CA 2318566).

3. Emoto teaches acidic (pH 3.3-4) gel foods comprising proteins, saccharides, organic acids, organic acid salts, emulsifiers and gelling agents (p. 5).

4. Claims 7-12 to acidic gel foods are product-by-process claims. The patentability of a product does not depend on its method of production. The products made by Applicants' process would be the same as the products taught by Emoto. Therefore, Emoto anticipates Applicants' claims 7-12.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emoto (CA 2318566) in view of Morehouse et al. (3,966,971).

7. Emoto teaches a process for preparing gelled food products having a pH of 3.3 to 4 and comprising protein, organic acid, organic acid salt, and a gelling agent. The protein is present in solution in an amount ranging from 0.2 to 30%. The organic acid is present in solution in an amount ranging from 0.02 to 2.5%. The organic acid salt is present in solution in an amount ranging from 0.02 to 2.5%. The gelling agent (anionic polymer) is present in the solution in an amount ranging from 0.02 to 2.5% (p.5).

8. Emoto teaches that the proteins used may be soybean protein, salts of the proteins, extracts of the proteins or concentrates of the proteins (p. 11). The organic acid and organic acid salt used may be selected from those conventionally used in foods or drinks (p. 11). The gelling agent may be pectin (p. 13).

9. Emoto goes on to teach that the mixture is heated. In example 4, an acidic gel food comprising soybean isolate and decomposed soybean protein is heated at 90°C for 10 minutes (pp. 23-24).

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10. Emoto presents the amounts of components in his solution as percentages instead of mM. Without knowing the specific acids and salts to be used, a direct conversion of the amounts cannot be made by the examiner. However, using calcium citrate added at 2.5% of the solution, the concentration would be approximately 5 mM. From this, the examiner interprets the mM concentration ranges claimed by Applicants' to be obvious over the percent range taught by Emoto.

11. Emoto is silent as to the use of an acid-soluble soybean protein in his invention.

12. Morehouse et al. teach an acid-soluble protein that has a good solubility and clarity in food compositions ranging from pH 3 to 5 (col. 1 lines 27-30). The protein may be isolated from soybeans (col. 1 lines 36-38).

13. Morehouse et al. go on to state that their protein isolated from soybean was completely soluble in water at concentrations up to 10% (col. 5 lines 20-25). They do not report the pH of the water. However, one of ordinary skill in the art would have reasonably expected that solubility of the proteins taught by Morehouse et al. would be greater than 90% at pH 4.5 given the method by which the proteins were obtained.

14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the acid-soluble soybean protein as taught by Morehouse et al. in the gelled foods as taught by Emoto in order to result in a gelled food product with improved clarity and texture from the dissolved protein.

15. Additionally, one of ordinary skill in the art at the time the invention was made would have possessed the ability to alter the amount of components as taught by

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Emoto, along with the acid-soluble protein as taught by Morehouse et al. in order to result in gelled food products with desirable flavor and texture properties.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/585,661. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a method for producing an acid-soluble soybean protein-containing gel and comprise mixing the protein with water and a polar solvent (alcohol).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 7-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/579,972. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and 10/579,972 are claiming an acidic protein food or drink comprising anionic polymers (saccharides), alkali metal salts of organic acids and acid-soluble protein of soybean origin. Further, the claimed pH range of the food product overlaps significantly.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 4174

Nikki H. Dees
Examiner
Art Unit 4174